

00766.000046

PATENT APPLICATION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
HIROMASA MIYAJI ET AL. ) : Examiner: N/Y/A  
Application No.: 09/763,793 ) : Group Art Unit: N/Y/A  
Filed: February 27, 2001 ) :  
For: NOVEL POLYPEPTIDE ) : May 21, 2004

Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450  
**Attention: Patricia Booker**

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

Sir:

This is in response to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. §371 IN THE U.S. DESIGNATED/ELECTED OFFICE (DO/EO/US) mailed April 7, 2004 (form PCT/DO/EO/905), copy attached at Tab A.

The Notification requires (i) submission of an oath or declaration, (ii) a \$130.00 surcharge for filing the oath or declaration later than 30 months from the priority date, and (iii) additional claim fees of \$1154.00.

In response, Applicants wish to point out that an executed declaration accompanied their original papers.<sup>1/</sup> A copy of that executed declaration is enclosed at Tab B. A copy of Applicants' stamped return-receipt postcard is attached at Tab C.

Accordingly, the requirement for an oath or declaration should be withdrawn.

As to the surcharge for late filing the declaration, therefore, none is thought to be required. Nonetheless, in order to expedite resolution of all issues, any fees required therefore may be charged to Deposit Account No. 06-1205.

As to the surcharge for additional claims ("\$864 for 48 total claims over 20. \$290 for multiple dependent claim surcharge") Applicants paid \$3578 when the application was filed (see the postcard at Tab C) for 156 claims and multiple dependencies. A copy of their cancelled check is attached at Tab D.

Accordingly, the Commissioner is hereby respectfully requested to credit deposit account No. 06-1205 for any overpayment. Nonetheless, again in order to reduce all issues, if for some reason further claim fees are required, such may also be charged to deposit account No. 06-1205.

In either event, please issue correspondence directed to the undersigned explaining how this fee discrepancy is resolved.

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<sup>1/</sup> Applicants previously filed, on May 4, 2004, a Request for Clarification of Decision on Petition pointing out that the formal papers in this case were complete.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below listed address.

Respectfully submitted,

  
\_\_\_\_\_  
Attorney for Applicants  
Lawrence S. Perry  
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/763,793	Hiromasa Miyaji	766.46
INTERNATIONAL APPLICATION NO.		
PCT/JP99/04602		
IA. FILING DATE		PRIORITY DATE
08/26/1999		08/27/1998
CONFIRMATION NO. 3687		
371 FORMALITIES LETTER		
*OC000000012280505*		

00766.0000046  
 USP  
 6/24/04  
 5/4/04 (JW)

Date Mailed: 04/07/2004

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 12/03/2003
- Copy of the International Search Report filed on 12/03/2003
- Copy of IPE Report filed on 12/03/2003
- Preliminary Amendments filed on 12/03/2003
- Request for Immediate Examination filed on 12/03/2003
- Copy of references cited in ISR filed on 12/03/2003
- U.S. Basic National Fees filed on 12/03/2003
- Assignment filed on 12/03/2003

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.
- Additional claim fees of \$1154 as a non-small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
- \$130 Late oath or declaration Surcharge.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is **\$1284** for a Large Entity:

- Total additional claim fee(s) for this application is **\$ 1154**

- **\$864** for 48 total claims over 20.
- **\$290** for multiple dependent claim surcharge.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

PATRICIA A BOOKER

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Telephone: (703) 305-3738

**PART 1 - ATTORNEY/APPLICANT COPY**

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U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/763,793	PCT/JP99/04602	766.46

FORM PCT/DO/EO/905 (371 Formalities Notice)

**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR PATENT COOPERATION TREATY APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled Novel Polypeptide

, the specification of which was filed as PCT International Application No. PCT/JP99/04602 on August 26, 1999 and was amended under PCT Article 19 on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) on which priority is claimed:

Country	Application No.	Filed (Day/Mo./Yr.)	Priority Claimed (Yes/No)
Japan	P. Hei. 10-241248	27/August/1998	Yes

I hereby appoint the practitioners associated with the firm and Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and direct that all correspondence be addressed to the address associated with that Customer Number:

FITZPATRICK, CELLA, HARPER & SCINTO  
Customer Number: 05514

I hereby declare that all statements made herein of my own knowledge

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COME AND DECLARATION AND POWER OF ATTORNEY  
FOR PATENT COOPERATION TREATY APPLICATION

(Page 2)

are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Sole or First Inventor Hiromasa MIYAJI

Inventor's signature Hironao Miyaji

Date Feb. 20, 2001 Citizenship/Subject of Japan

Residence Shizuoka, Japan

Post Office Address 234-16, Honjuku, Nagaizumi-cho, Sunto-gun, Shizuoka  
411-0945 Japan

Full Name of Second Joint Inventor, if any Hideki MIMURA

Inventor's signature Rideki Mimura

Date Feb. 20, 2001 Citizenship/Subject of Japan

## Residence Shizuoka, Japan

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411-0945 Japan

Full Name of Third Joint Inventor, if any Motoko HARUOKA

Inventor's signature Motoko Hasegawa

Date Feb. 20, 2001 Citizenship/Subject of Japan

Residence Shizuoka, Japan

**Post Office Address** 1194-115, Shimotogari, Nagaizumi-cho, Sunto-gun,  
Shizuoka 411-0943 Japan

Full Name of Fourth Joint Inventor, if any      Satoshi NAKAGAWA

Inventor's signature Satoshi Nakagawa

Date Feb. 20, 2001 Citizenship/Subject of Japan

Residence Tokyo, Japan

Post Office Address 3-9-9, Naka-machi, Machida-shi, Tokyo 194-0021  
Japan

Full Name of Fifth Joint Inventor, if any

Inventor's signature

Date                      Citizenship/Subject of

### Residence

Residence \_\_\_\_\_  
Post Office Address

Full Name of Sixth Joint Inventor, if any

Inventor's signature

Date \_\_\_\_\_ Citizenship/Subject of \_\_\_\_\_

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Express Mail No.: EL 144 484 013 US

Assistant Commissioner for Patents

Washington, D.C. 20231

Date 2 / 27 / 01  
Mo. Day Yr.

Atty. Docket 766.46

**091763793**

Rec'd PCT/PTO 27 FEB 2001

S Kindly acknowledge receipt of the accompanying:

Specification (100 pages); Oath or Declaration; Drawings (9 sheets); Sequence Listing (19 pages); Transmittal of Document for Recordation; Inventor Information Sheet; Preliminary Amendment; Form PCT/RO/101; Form PCT/IB/304; Form PCT/ISA/220; Form PCT/ISA/210; Form PCT/IB/308; Front page of International Pub. No. WO00/12550; Form PCT/IPEA/416 and Form PCT/IPEA/409; Form PCT/IB/338; Form PCT/IPEA/409 (Translation); Form PCT/IB/306; \$3618.00 check for filing fee and assignment recordal fee

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Due Date 2 / 27 / 01  
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37 CFR 1.8   
37 CFR 1.10   
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NEW YORK, NY 10112	
COMMISSIONER OF PATENTS AND TRADE MARKS	
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